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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/267,100	07/19/99	VAN DER VOORT	C 082671/0105

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HM22/1004

EXAMINER

GRUNBERG, A

ART UNIT	PAPER NUMBER
1661	3

DATE MAILED: 10/04/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/357,103**

Applicant(s)  
**Cees A. Van Der Voort**

Examiner  
**Anne Marie Grunberg**

Group Art Unit  
**1661**



☒ Responsive to communication(s) filed on Jul 19, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

## **DETAILED ACTION**

### **Status of Application**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

### **Drawings**

The drawings have been approved by an official draftsman.

### **Objection to the Oath**

The oath is objected to because the term "and/or asexually reproduced the new and distinct plant variety" contradicts 37 CFR 1.162 which states "The applicant for a plant patent must be the person who has invented or discovered **and** asexually reproduced the new and distinct variety of plant...(emphasis added). This objection may be obviated by deleting "/or". A new declaration is required. No new fees are required.

### **Objection to the Disclosure**

#### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

### 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The term "vigorous" at page 4, line 12 is unclear and subjective. As a result, and in the interest of providing as complete a botanical description as is reasonably possible, Applicant should quantitatively define "vigorous". Additionally, Applicant should define pedicel form at page 5, line 23.

B. Since the internode length is a distinctive characteristic of the instant plant, Applicant should set forth the internode length

C. In the interest of providing as complete a botanical description of the instant variety as is reasonably possible, Applicant should set forth the color designation for the bulb, accents on the bud, flower mid-vein, pedicel, and a color designation for each of the reproductive organs.

D. Applicant should clarify "medium" disease resistance at page 5, line 25.

E. Since lasting quality is a distinctive characteristic of the instant cultivar, Applicant should clarify the "excellent" quality quantitatively.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

### **Claim Rejections**

#### **35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

#### **35 U.S.C. 102(d)**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

The claim is rejected under 35 U.S.C. 102(d) as being barred by applicant's Breeder's Right numbers: NL PBR LEL1147 granted in The Netherlands on 16 May 1995, on an application filed on 5 November 1993. Additional Breeder's Right numbers include BE PBR 25125 filed 22 September 1995; CL PBR 00037 filed 13 November 1995; FR PBR 0158497 filed 4 September 1995; NZ PBR LIL025 filed 15 May 1995; PL PBR LIO0050 filed 4 December 1995; and DE PBR LIU 00079 filed 6 September 1995. Since the Breeder's Right provides patent-like protection to the named variety, it is deemed to be an "inventor's certificate" within the meaning of 35 U.S.C. 102(d). It appears that the Breeder's Right was granted for the same plant as claimed in the instant application, and was granted to Applicant or his legal representatives or assigns. Therefore the delay in filing for a U.S. patent has resulted in the loss of right under 35 U.S.C. 102(d).

#### **Future Correspondence**

Any inquiry concerning this communication from the Examiner should be directed to Anne Marie Grünberg whose telephone number is (703) 305-0805. The

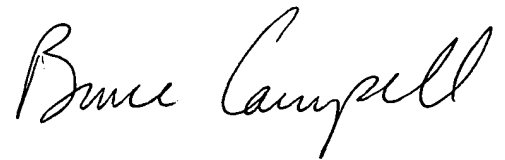
Serial Number: 09/357,103  
Art Unit: 1661

Page 7

Examiner can normally be reached Monday through Thursday from 6:00 am to 3:30 pm and alternate Fridays from 7:00 am to 3:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205. The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



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